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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,270	08/07/2001	Kenji Takahashi	MM4461	4894

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ANDERSON, KILL & OLICK, P.C.
1251 AVENUE OF THE AMERICAS
NEW YORK,, NY 10020-1182

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/22/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,270

Applicant(s)

TAKAHASHI ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/04 has been entered.

Information Disclosure Statement

The IDS of 5/17/04 has been made of record. The JP report listed thereon has not since there is no English translation thereof. The previously submitted JP document listed on this IDS has been crossed out, since it has already been considered.

The examiner has reviewed the case and arguments and presents the following rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 102

1. Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by Shinozuka et al.

Applicants' attention is drawn to figure 8 in Shinozuka et al – as far as the examiner interprets the claims, all elements are depicted therein with the exception of a lens. However, since the lens holder is present, obviously a lens will be placed therein. The frame is element 35 and the protrusion therefrom as it finds itself in between the two projections (above and below such protrusion) is interpreted as the projections and the another projections.

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2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-093173 further considered with JP 10-198986.

As indicated in the abstract – and further depicted in the accompanying MAT (machine assisted translation) – see in particular paragraph 003 – 0010, the stoppers are associated with the lens holder. There is no clear depiction of stoppers (protrusions) associated with a frame.

The secondary JP document teaches such stoppers.

It would have been obvious to modify the base system of JP 2001-093173 with the additional teachings from the secondary JP document, motivation is to ensure stable operation of the optical system in instances of adverse motions.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masunaga further considered with JP 10-198986.

In Masunaga, the lens is element 147, lens holder – element 148, suspension holder 142 (a), the plurality of elastic supports 153, and actuator – not shown. With respect to the plurality of projections from the lens holder, as depicted in figure 2 thereof, although not labeled, the lens holder has a set of protrusions on either side – upper and lower elements, in which the elastic elements (153) are attached.

Although there is a frame, it is not clear that such an element has any additional projections.

Jp 10-108986 document teaches additional stopper projections 20 & 21, which prevent deformation of the springs in this environment. They are attached to a frame.

It would have been obvious to modify the base system of Masunaga with the additional teachings from the above noted JP document, motivation is as taught by the abstract thereof, to prevent spring deformation in conditions of excessive force.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection as well as the above interpretations of the references.

4. Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by either Masunaga or Tomiyama et al

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With respect to the independent claim, the above document depicts a protrusion/projection at various locations:

a) Masunaga, the lens is element 147, lens holder – element 148, suspension holder 142 (a), frame 30, plurality of elastic supports 153, and actuator – not shown. With respect to the plurality of projections including first and second projections – as depicted in figure 2 thereof, the lens holder has protrusions (upper and lower) in pairs on both sides thereof. The elastic wires/element 153 end thereat, and hence are attached thereto.

Alternatively, with respect to claim 2, the elastic supports are fixed to the first projections, either the top or bottom portion of element 153b – see figure 9, while the second projection is the remaining projection, i.e., the bottom or top portion of the projection 153b in Masunaga.

As amended and interpreted, the claim recites a plurality of projections, wherein these projections are found on the lens holder – see figure 2 in Masunaga and the frame – see the description with respect to the frame elements 30a, or 153a.

Response to Arguments

Applicant's arguments filed ^{4/14/07}~~10/20/05~~ have been fully considered but they are not persuasive.

The examiner has not ignored the functional language contained in claim 2, that these projections act as stoppers. The examiner interprets the projections in claim ²~~1~~ to be those found on the frame and the lens holder. These are found in the Masunaga reference. With respect to the functional limitation with respect to these acting as stoppers that restrict rotation of the lens holder, the examiner concludes that this function follows from the structure of elements found in the claim, and hence since these elements are found, it also flows from the reference.

b) Tomiyama et al – see figures 2 and 4. The projections are 2b, 2c, 2d, 2e attached to the lens holder, while projects 6a, 6b, 6c, and 6d are the projections attached to the suspension holder.

With respect to claim 2, the first projections – either those attached to the suspension holder and there is a first and second, i.e., with respect to claim 2, the first projections any of 2b, c, d, e and the second projections any of the remaining projections 2b, c, d, e.

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As far as the examiner interprets applicants' termed projections, the above documents meet this limitation. The remaining claimed elements are self-evident.

Furthermore, as best as examiner can interpret from the above documents, the limitations of claim 7 follow, the outer surfaces of these projections project from the lens holder approximately the same distance.

Response to Arguments

Applicant's arguments filed ^{4/14/04}~~10/29/03~~ have been fully considered but they are not persuasive.

Again, the examiner concludes that the stopping action is a conclusion from the elements provided, and hence because these elements are found in the reference, the stopping ability is met.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as obvious over the cited documents above with respect to claim 2 further considered with JP 62-031036.

With respect to claim 3, the position defined is considered evident in the JP document.

The examiner interprets the limitations of claim 3 as a relocation of the projections, i.e., a relocation of parts, and obvious to one of ordinary skill in the art, since the function would still be retained.

The positioning of the projections would be a matter of choice by the manufacturer of the lens holder, as part of any molding technique. No unexpected results/or criticality is seen to occur from relocating these projections.

With respect to the limitations of claim 4, since there are four projections in the base reference, these limitations are met.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above, and further in view of Wada et al.

Selection of elastic elements as defined in claim 6 is taught by the Wada et al reference.

Substituting such for the elastic members in any of the above noted prior art systems are merely a selection of equivalents with no unexpected results occurring from such a substitution.

5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Tomiyama et al.

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Applicants' attention is drawn to figures 1, 2 and four and the description thereof.

As noted, in figure 2, the examiner interprets the first projections as 2b,d and the second projections as 2c,e. The distance limitations are considered inherently present because the second projections are closer to the recording surface than the first projections 2b,d. The examiner interprets the last wherein phrase as met by this configuration of projections.

With respect to the amended limitation (elastic supports are fixed to the lens holder), as noted at col. 2, lines 54-59, the elastic elements 4 a,b,c,d are mounted onto the projections 2,b,c,d,e. Since these are formed/part of the lens holder 2, the elastic supports are fixed thereto.

Conclusion

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning the merits of this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
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AMP